

REMARKS

Reconsideration of the application in light of the above amendments and the following remarks is respectfully requested.

Applicants appreciatively acknowledge the courtesy and effort extended by the Examiner in conducting an August 16, 2005 telephone interview with their attorney, Richard J. Katz. During the interview the Herz reference as applied by the Examiner to the independent claims was discussed. The Examiner indicated that Herz discloses relevancy of an ad by merely doing a word count, while Applicants stated that Herz does not determine the relevancy of any metric (e.g., a word count) until Herz compares the metric with a user profile. Applicants further stated that the claimed invention does not rely on a user profile to determine relevancy of an ad to a web page's content. An agreement was not reached.

Claims 15, 16, 21, 22 and 27-89 are pending. Claims 15, 21, 31, 35, 40, 43, 44, 46, 87 and 89 have been amended. The amendments to claims 31, 35, 40, 43, 44, 46 and 87 set forth which rule base is being invoked in the claim, without changing the scope of the subject matter recited therein. No new matter has been added. The changes to the claims address issues raised by the Examiner, so they could not have been presented earlier. Further, no new issues requiring further search or consideration by the Examiner are presented, so this amendment should be entered.

Rejection Under 35 U.S.C. § 102

Claims 15, 16, 21, 22, 27, 29, 31, 33-35, 37-89 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,835,087 to Herz et al. ("Herz"). As demonstrated below,

Applicants submit that Herz does not disclose determining the level of relevancy of an advertisement, free of any information about the user, based on the content being delivered to the user. Therefore, Applicants submit that Herz does not anticipate the claimed invention.

The claimed invention and the Herz disclosure are fundamentally very different systems. The claimed invention could be styled a “pull and drag” system. That is, the user goes on the Internet seeking content which is pulled to his work station. The act of pulling certain content implements the claimed invention with the effect of dragging an advertisement, which is relevant to the pulled content, to the work station for display with the content. In contrast, Herz discloses a “push” system. The Herz system also receives new articles, which can be advertisements or coupons. Based on the user’s prior choices, it pushes the new article or advertisement to the user for display by itself, and not together with any content the user has actively sought.

The two systems differ in their details. When the Herz system receives an article or advertisement, it parses it to create a target profile of the article or advertisement according to system rules. Thus, all articles and ads are parsed by Herz’s system in the same way according to the system rules; the rules being applied to the content of the article or advertisement itself. In the claimed invention there are “**a set of relevancy rules associated with each ad.**” Thus, the advertiser themselves can set unique rules for each ad as to how the ad’s relevancy is to be determined, without any defined relationship to the content of the ad. For example, the advertiser can set a rule that its ad is to be sent to any visitor to the site or visitors to the site that are reading about element X, even though the ad only contains element Y. This results in a system with greater flexibility.

The Herz system is initiated by receipt of a new article or advertisement by the system. The present invention is initiated by “**the user station allowing the user to retrieve information containing content.**”

In the Herz system the selection of material to be sent to the user is based on a comparison of the user profile (i.e., stored information about choices made by the user in the past) and the profile of the article or advertisement created by parsing them. In the claimed invention the selection of the material to be sent to the user is based in part on **extracting the “content [retrieved by the user] according to extracting rules”** (not the advertisement as in Herz) and **parsing “the content of the information into objects.”** Then the system **applies the unique “relevancy rules in the data store to the objects, free of information about the user.”** As noted, Herz’s system relies on information about the user to create the user profile which is at the heart of Herz’s selection process.

Finally, Herz sends one or more of the articles or advertisements to the user for consideration by itself. In the claimed invention the system **“directly sends the targeted ad to the station for display with the content”** that the user currently requested to view.

The Examiner contends that Herz discloses “that the target profile for the electronic media is based solely on the frequency with [which] the words appear in an article (col. 6, lines 34-46).” (Detailed Action, page 3, item 3.) Further the Examiner, citing Herz, column 6, lines 42-46, contends that Herz discloses that “[the] first module targets the ads solely on the frequency of the words that appear on the article.” (Detailed Action, page 5, item 6.) Applicants respectfully disagree.

Applicants submit that Herz discloses (1) a first module that “constructs a ‘target profile’ for each target object in the electronic media based on various descriptive attributes of the target object;” (2) a second module that “construct[s] a ‘target profile interest summary’ for each user,” where the target profile interest summary can be a plurality of search profiles that each “corresponds to a single topic of interest for the user;” and (3) “a profile processing module which estimates each user's interest in various target objects by reference to the users' target profile interest summaries, for example by comparing the target profiles of these target objects against the search profiles in users' search profile sets, and generates for each user a customized rank-ordered listing of target objects most likely to be of interest to that user.” (Herz, column 6, lines 42-58 (emphasis added).)

Herz discloses a newsclipping service that scans articles and presents the articles to a user as possible content for display. Herz discloses ranking the content based on the user's likely interest, and sending the content to the user according to its rank. In the claimed invention, the system is put into operation through a user's request for retrieval of content available on the Internet, the content existing entirely independent of the ad that the invention delivers with that content (i.e., the delivered ad does not necessarily exist anywhere on the Internet accessible directly by user request). Further, Herz determines the relevancy of the article in conjunction with a user profile and the ranking derived from the article's content. **The claimed invention is more flexible than the Herz system in that with the claimed invention there is no defined relationship between the relevancy rules and the content of the ad.** For example an advertiser might use the claimed invention to show travel ads on pages that discuss depression, if they believe that people reading about depression might be interested in travel, even though the travel ad and the depression page do not share a common profile or keywords. Herz does not disclose these features, rather Herz

discloses merely matching articles previously read by a user to articles unread by the user, where both articles have matching target profiles. As opposed to Herz, the claimed invention is able to function as a marketing and sales tool for advertisers who want to offer their products and services to users based only on the content retrieved by that user.

Assuming *arguendo* that “the target profile for the electronic media is based solely on the frequency with [which] the words appear in an article,” as the Examiner contends, the rank-ordered listing of the electronic media is not determined by Herz until the profile processing module compares the media’s target profile with the users’ search profile sets. Herz discloses that only after this comparison does the system generate a customized rank-ordered listing (i.e., relevancy). In contrast, the claimed invention delivers relevant ads without reference to a user profile.

In the interest of advancing prosecution of this application to allowance, independent claims 15, 21 and 89 have been amended. Independent claim 15 has been amended to recite relevancy “rules operable to indicate a level of relevancy of the ad to the content of the information retrieved,” a match maker that “parses the content of the information into objects, and targets an ad from the server to the content by applying the relevancy rules in the data store to the objects, free of information about the user,” and that the claimed system “sends the targeted ad to the station for display with the content.” Claims 21 and 89 have been amended to recite similar subject matter.

In contrast to matching the level of relevancy between the ad and the content free of information about the user (as recited in the claims), Herz discloses that the rank-ordered listing is generated by “comparing the target profiles of these target objects against the search profiles in users' search profile sets.” (Herz, column 6, lines 42-58.) Thus, Herz does not disclose, nor

suggest, determining relevancy of an ad to content retrieved by a user, free of information about the user. Therefore, Herz does not disclose each and every feature of the claims. Herz does not anticipate the invention of claims 15, 21 and 89.

Applicants note that other amendments were also made to claims 15, 21 and 89. For instance, the phrase “free of information about the user” was moved from line 7 to line 11 of claim 15 so as to clarify that the rules are applied free of information about the user. Additionally, the distinction between the two rule-bases already recited in the claims is now better set forth with the terms “relevancy rules” and “extracting rules.” One rule-base in the data store determines a level of relevancy of the ad. The other rule-base is in the match maker and extracts the content. Applicants submit that these terms are of a minor typographical nature, do not change the scope of the claims, do not add new matter, do not require a new search, and require no substantial or additional work by the Examiner or the Patent and Trademark Office.

Attached hereto is **Exhibit A**, which provides a side-by-side comparison between Herz and the claimed invention. As demonstrated above and shown in Exhibit A, Herz discloses finding new articles or advertisements 904 that might be of interest to a user by applying system-wide rules. The relevancy of the new article or advertisement 904 is determined by Herz (1) developing a target profile 906, which relates to the content of the article or advertisement; (2) creating a user profile 902, which reflects user viewing history and demographics; and (3) comparing 908 the target profile and user profile to determine if the new article or advertisement is of interest to the user. Herz then transmits 910 the new article or advertisement to the user 912.

In contrast, the claimed invention bases the relevancy of an advertisement using relevancy rules 805 provided by the advertiser to a system data store 810. The relevancy rules are applied to content requested by a user at user station 825 from an Internet site 820. A matchmaker 815 access and extracts the user-requested content, parses it into objects, and applies the relevancy rules in the data store 810 to target ads.. The relevant advertisement is sent to the user station 825 to be viewed alongside the content provided to the user station from the Internet site 820. Unlike Herz's system, the claimed invention does not rely on a viewer's previously viewed content or demographics. Further, while the claimed invention provides the relevant advertisement to be viewed with the content requested by the user, Herz merely determines what article, advertisement or coupon might be of interest to a user based on that item's content and transmits the item to the user as a selectable viewable content.

In the Herz system the new article or ad is sent to the user for display. However, only the article is displayed. The amended independent claim 15 recites “displaying the targeted ads at the station with the content.” (Emphasis added.) Amended independent claims 21 and 89 recite similar subject matter. The claimed invention performs real-time ad placement contextually based on what is relevant to the user’s current interest on the Internet. In contrast, Herz discloses a historical-based process that analyzes article content with a user’s prior viewing habits to project what future documents the user might be interested in viewing. This is yet a further distinction from Herz.

Claims 16, 27-31, 32-35, 37-39 depend from claim 15. Claims 22, 40-88 depend from claim 21. Applicants submit that claims 16, 22, 27-31, 32-35 and 37-88 are patentable over Herz

for at least the same reasons as their respective base claims. Reconsideration and withdrawal and is requested.

Rejection Under 35 U.S.C. § 103

Claims 32 and 36 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Herz in view of the Examiner’s statement of what was known in the art at the time of the invention.

The Examiner contends that Herz discloses most of the features of claims 32 and 36. However, the Examiner acknowledges that Herz does not disclose that performance is measured by a change in revenues or click-through rates (claim 32), nor that content is classified by past consumption by users as a consequence of ads that were received and responded to by them (claim 36). The Examiner states that these approaches are “old and well known in the computer related arts,” and that it would have been obvious for a person of ordinary skill in the art to have combined Herz and the Examiner’s statement of what is “old and well known” at the time of the invention to achieve the invention of claims 32 and 36.

Claims 32 and 36 depend from amended independent claim 15, and recite the features of claim 15 as if set forth therein in its entirety. In the previous section, Applicants have demonstrated that claim 15 is patentable over Herz. The above discussion is equally applicable to claims 32 and 36 in view of Herz and the Examiner’s statement. Applicant submits that the Examiner has not established a *prima facie* case of obviousness over claims 32 and 36. Reconsideration and withdrawal of the rejection is requested.

CONCLUSION

Applicants submit that the claimed invention is fundamentally a “pull and drag” system, while Herz discloses a “push” system. In summary, the following are key distinctions of the claimed invention over Herz’s teachings:

1. The methods of determining relevancy are different between the claimed invention and Herz. Herz discloses: scanning all available and accessible articles (including those which are ads and coupons) to generate target profiles; and determining a match and rank utilizing both target profiles and user profiles in conjunction. The claimed invention discloses: scanning content currently requested for view by the user; and determining a match and rank by applying relevancy rules to the scanned content of the requested material (with no need to scan advertisements). Thus, the claimed invention provides a marketing and sales tool for advertisers to deliver their ads according to specified matching rules applied to content requested by a user.
2. The two systems are initiated in different ways. In Herz, the system is initiated by receipt of a new article into the system. In the current invention, the system is initiated by the user workstation allowing the user to retrieve information containing content.
3. The two systems deliver the ad to the user in different ways. In Herz, the content (whether an article, advertisement, or coupon) is delivered for consideration by itself. In contrast, the claimed invention delivers advertisements for display together with the content requested to be viewed by the user.

Each and every point raised in the Office Action dated July 13, 2005 has been addressed on the basis of the above amendments and remarks. In view of the foregoing it is believed that Claims 15, 16, 21, 22 and 27-89 are in condition for allowance and it is respectfully requested that the application be reconsidered and that all pending claims be allowed and the case passed to issue.

If there are any other issues remaining which the Examiner believes could be resolved through a Supplemental Response or an Examiner's Amendment, the Examiner is respectfully requested to contact the undersigned at the telephone number indicated below.

Dated: December 13, 2005

Respectfully submitted,

By _____

Richard J. Katz

Registration No.: 47,698

DARBY & DARBY P.C.

P.O. Box 5257

New York, New York 10150-5257

(212) 527-7700

(212) 753-7701 (Fax)

Attorneys/Agents For Applicants